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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,266	12/31/2003	John B. Abjanic	1020.P8759D	1751

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KACVINSKY LLC
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EXAMINER

NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
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2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/750,266

Applicant(s)

ABJANIC, JOHN B.

Examiner

Phuoc H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/23/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 02/23/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. However, no copy of each non-patent literature publication is provided.

Specification

2. The disclosure is objected to because of the following informalities:

The applicant is advised to update information cited under the "Cross-reference to related applications" section in original disclosure.

In addition, the applicant is advised to rewrite the acronym XML in full at least once in the independent claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "may" in claim 12 is a relative term which renders the claim indefinite. The term "may" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Ayyagari et al. (U.S. 7,020,681).

Re claim 1, Ayyagari et al. disclose in Figures 1-6 a network apparatus (e.g. Figure 1 and abstract) comprising: an XML checker to determine if a received message includes XML information (e.g. step 410 in Figure 5A wherein the proxy determines whether the message is an XML message); the network apparatus adapted to switch the message to an output port (e.g. port A as No the question above in Figure 5A) or to a selected processing node (e.g. port B as Yes to the question above in Figures 5) based

upon business transaction information provided in XML in the message if the message includes XML information (e.g. col. 1 lines 40-45 and col. 4 lines 2-10).

Re claim 2, Ayyagari et al. further disclose in Figures 1-6 the network apparatus is adapted to switch or forward the message substantially without XML processing if the message does not include XML information (e.g. col. 6 lines 5-25 wherein it only takes a look at the xml header in particular predetermined format).

Re claim 3, Ayyagari et al. further disclose in Figures 1-6 the network apparatus comprises a traffic manager (e.g. 200 as XML proxy and monitor in Figure 1).

Re claim 4, Ayyagari et al. further disclose in Figures 1-6 the network apparatus comprises a network processor (e.g. col. 5 lines 40-45).

Re claim 5, Ayyagari et al. further disclose in Figures 1-6 a content based message director to switch messages to one of a plurality of output ports (e.g. Figure 5 wherein either route to remote servers, local cache, client directly) or one of a plurality of processing nodes based upon comparing business transaction information provided in XML to a configuration pattern (e.g. col. 1 lines 40-45 and col. 4 lines 2-10).

Re claim 6, Ayyagari et al. further disclose in Figures 1-6 the network apparatus comprises an XML parser to parse XML information in the received message (e.g. col. 6 lines 5-25 wherein it only takes a look at the xml header in particular predetermined format).

Re claim 7, it is a method claim of claim 1. Thus, claim 7 is also rejected under the same rationale as cited in the rejection of rejected claim 1.

Re claim 8, it is a method claim of claim 2. Thus, claim 8 is also rejected under the same rationale as cited in the rejection of rejected claim 2.

Re claim 9, it is a method claim of claim 6. Thus, claim 9 is also rejected under the same rationale as cited in the rejection of rejected claim 6.

Re claim 10, it is a method claim of claim 5. Thus, claim 10 is also rejected under the same rationale as cited in the rejection of rejected claim 5.

Re claim 11, Ayyagari et al. further disclose in Figures 1-6 performing one of the following on the message if there is no match between the XML business transaction information and the configuration pattern: directing the message to a default location (e.g. 420 in Figure 5A); and blocking or not forwarding the message.

Re claim 12, Ayyagari et al. further disclose in Figures 1-6 the configuration pattern may indicate one or more of the following: a source or From entity of the message; a destination or To entity of the message (e.g. either the source or destination or both must exist in the message for identification purposes); a type of transaction; and a purchase amount.

Re claim 13, Ayyagari et al. further disclose in Figures 1-6 the determining if the received message includes XML information comprises performing one of the following: detecting a certain filename or type of filename in the message; detecting a certain type of filename extension in the message; examining header information in the message; and examining one or more tags in the message (e.g. col. 6, lines 5-25).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-4 of U.S. Patent No. 6,732,175. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 2, 3, and 4 of U.S. Patent No. 6,732,175 contain every element of claims {3}, {4}, and {1-2 and 5-10} of the instant application and thus anticipate that claims of the instant application. Claims of the instant application therefore are not patently distinct from the earlier patent claims and as such are unpatentable over obvious-type double patenting. A later patent claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).

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" ELI LILLY AND COMPANY v BARB LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "**anticipated**" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4 . This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Deen et al. U.S. Patent No. 6,629,127

Abjanic U.S. Patent No. 6,732,175

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919.

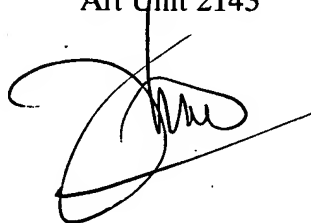
The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Phuoc H Nguyen
Examiner
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A handwritten signature in black ink, appearing to be 'Phuoc H Nguyen', written over the printed name and title.

January 8, 2007